

REMARKS

Claims 1, 3-5, 7-19, and 21-30 remain in the application. Claims 1, 3-4, 7-10, 12-18, 21-25, and 27-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number 5,497,314 issued to Novak (hereinafter "Novak"). Claims 5, 11, 19, 26, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak in view of U.S. Patent Number 6,366,696 issued to Hertz (hereinafter "Hertz").

Claims 1, 4, 9-10, 13, 16, 24, and 27 are amended to more particularly point out and distinctly claim the subject matter of the claimed invention. The amendments are fully supported by the specification.

Response to rejections of claims 1, 3-4, 7-10, 12-18, 21-25, and 27-30 under 35 U.S.C. § 103(a)

Claims 1, 3-4, 7-10, 12-18, 21-25, and 27-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Novak. Applicant respectfully traverses these rejections.

It is well settled that the PTO has the burden to establish a *prima facie* case of obviousness. *In re Glaug*, 2002 U.S. App. Lexis 4246, *4 (Fed. Cir. March 15, 2002); MPEP §2142. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03 (emphasis added). The Federal Circuit has held that "the 'subject matter' that must have been obvious to deny patentability under §103 is the entirety of the claimed invention," *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir. 1987). Furthermore, even if all the claim limitations are taught or suggested, there must be some suggestion or motivation to combine reference teachings. See MPEP §2142. Applicant respectfully asserts that a *prima facie* case of obviousness has not been

made because not all the elements recited in the claims are taught or suggested by the prior art.

Claims 1, 9, 13, 16, 24, and 27 are amended to include “an association module configured to identify the item in a database based on the coded identifier; and a verification module configured to verify the identity of the item based on the visual characteristic;” Amended claim 1, underlined for emphasis. See also claims 9, 13, 16, 24, and 27. The amendment is supported by the specification. Specifically, the specification discloses “Alternatively, the association module 306 may use the coded identifier 104 as the primary search criteria.” Page 12, lines 19-22. Thus the embodiment of the present invention claims using the coded identifier to identify an item in the database and verifying the identification with the visual characteristic.

In contrast, Novak teaches using the coded identifier as secondary identification devices. Novak, column 8, lines 22-25. Novak teaches using the visual characteristics to make the identification, with coded identifier verifying the identification. Novak, abstract. In addition, Novak teaches away from using the coded identifier to identify items because of the problems with using coded identifiers for primary identification. Novak, column 2, lines 2-7. Because Novak does not disclose identifying an item with a coded identifier and verifying the identification with visual characteristics, Novak does not teach each element of the embodiment of the present invention. Therefore Applicants respectfully assert claims 1, 9, 13, 16, 24, and 27 cannot be obvious over Novak and are allowable.

In addition, claims 1, 9, 13, 16, 24, and 27 are amended to include “...a presentation module configured to provide audio information about the item...” and “...providing audio information about the item...” Claims 1, 9, 13, 16, 24, and 27. The amendment is well supported

in the drawings and specification. Figure 3 depicts a confirmation module 204 with a presentation module 310. The presentation module 310 may include speakers configured to provide audio information including the visual characteristics of one or more items and the name of one or more items. Page 16, lines 3-9.

In contrast, Novak does not teach "providing audio information about the item." Instead Novak teaches providing feedback through a video display screen. Because Novak does not teach each element claimed by the embodiment of the present invention, Applicants respectfully assert that claims 1, 9, 13, 16, 24, and 27 of the embodiment of the present invention cannot be obvious over Novak and should be allowed.

As a result of the presented remarks, Applicants assert that independent claims 1, 9, 13, 16, 24, and 27 are in condition for prompt allowance. Applicants have not specifically traversed the rejections of dependent claims 3-5, 7-8, 10-12, 14-15, 17-19, 21-23, 25-26, and 28-30 under 35 U.S.C. 103(a), but believe those claims to be allowable for depending from allowable claims. See, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Should additional information be required regarding the traversal of the rejections of the dependent claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,



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